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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/309,372

05/11/1999

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418268560US

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45979 7590 07/17/2009
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EXAMINER

NGUYEN, MAIKHANH

ART UNIT

PAPER NUMBER

2176

MAIL DATE

DELIVERY MODE

07/17/2009

PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENNETH LASSESEN

Appeal 2008-006312
Application 09/309,372
Technology Center 2100

Decided:¹ July 17, 2009

Before JOSEPH L. DIXON, THU A. DANG, and STEPHEN C. SIU,
Administrative Patent Judges.

DIXON, *Administrative Patent Judge.*

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

I. STATEMENT OF THE CASE

The Patent Examiner rejected claims 1-13. The Appellant appeals therefrom under 35 U.S.C. § 134(a). We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Invention

The invention at issue on appeal relates to a method for a user to translate an electronic file immediately by selecting a desired language (Spec. 3).

Illustrative Claim

Claim 6, which further illustrates the invention, follows.

6. A method of providing an electronic file to a user comprising the steps of:

assigning to at least one word in the electronic file a plurality of identifiers, wherein each identifier corresponds to one of a plurality of respective translations in the electronic file for said at least one word; and

at a receiving computer:

receiving the electronic file from a sending computer,

allowing the user to select a language in which at least a portion of the electronic file is to be displayed,

using an identifier from the plurality of identifiers,

wherein the identifier corresponds to the language selected by the user, to obtain, from the respective translations in the electronic file, a translation, in the language selected by the user, for said at least one word,

inserting the translation obtained from the electronic file into a translated electronic file, and

displaying the translated electronic file to the user.

References

The Examiner relies on the following references as evidence:

Kennelly	US 6,559,861	May 6, 2003
Flanagan	US 6,993,471	Jan. 31, 2006

Rejection

The Examiner makes the following rejection.

Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Flanagan in view of Kennelly.

II. ISSUE

Has Appellant shown the Examiner erred in the obviousness rejection of claims 1-13 by failing to identify a teaching of “assigning to at least one word in the electronic file a plurality of identifiers, wherein each identifier corresponds to one of a plurality of respective translations in the electronic file for said at least one word;... receiving the electronic file...to obtain, from the respective translations in the electronic file, a translation, in the

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language selected by the user, for said at least one word” in the prior art, as recited in representative independent claim 6?

III. PRINCIPLES OF LAW

Prima Facie Case of Unpatentability

The allocation of burden requires that the United States Patent and Trademark Office (USPTO) produce the factual basis for its rejection of an application under 35 U.S.C. §§ 102 and 103. *In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984) (citing *In re Warner*, 379 F.2d 1011, 1016 (CCPA 1967)). Appellant has the opportunity on appeal to the Board of Patent Appeals and Interferences (BPAI) to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) (citing *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

Scope of Claim

The claim construction analysis begins with the words of the claim. *See Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Absent an express intent to impart a novel meaning to a claim term, the words take on the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Brookhill-Wilk 1, LLC., v. Intuitive Surgical, Inc.*, 334 F.3d 1294, 1298 (Fed. Cir. 2003) (internal citations omitted).

Obviousness

The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

IV. FINDINGS OF FACT

We rely on the following Findings of Fact (FF) that are supported by a preponderance of the evidence.

1. Kennelly discloses that a computer system includes a memory containing a plurality of string values that correspond to text in different languages for displaying a page of a user interface in multiple languages (Spec. 21, Abst.). In particular, Kennelly discloses when a user selects a language other than the default language, e.g., French or Japanese, “management object request processor 156 proceeds to call the corresponding language data file 212_{fr} or 212_{jp}, i.e., the French or Japanese versions of STR_USER, depend on which language is selected, from the corresponding subdirectories 204, 206...” (col. 7, ll. 39-45, Figs. 6A-6B).

2. Flanagan discloses a computer system for translating a HTML document into different language HTML documents. In particular, Flanagan discloses that multiple pre-translated HTML pages are stored in parallel caches in the Web Server 104. When a user requests a specific page in a

specific language, the server 104 will retrieve a page of requested language and send it to the user (col. 5. ll. 28-50, Fig. 9).

V. ANALYSIS

In the Examiner's rejection, we find that the Examiner sets forth a detailed explanation in the initial showing of the *prima facie* case for obviousness. Therefore, we look to Appellant's Brief to show error in the Examiner's initial showing of obviousness.

Common Feature in the Claims

Independent claim 1, recites limitations, *inter alia*: "receiving the electronic file at the user's computer, wherein the electronic file's content includes a first plurality of phrases, wherein each phrase of the first plurality is expressed in a plurality of languages". Independent claim 6 contains similar limitations with different wording "assigning to at least one word in the electronic file a plurality of identifiers, wherein each identifier corresponds to one of a plurality of respective translations in the electronic file for said at least one word; and at a receiving computer: receiving the electronic file...to obtain, from the respective translations in the electronic file, a translation, in the language selected by the user, for said at least one word". Thus, the scope of each of the independent claims includes the following limitation: receiving an electronic file (HTML file or any type of electronic file) which *includes a plurality of translations/languages* for at least one word/phrase (emphasis added).

With respect to independent claim 6, Appellant contends that “Flanagan does not disclose downloading documents that contain words that are expressed in multiple spoken languages, such as English, French, Spanish, Italian and the like.” (App. Br. 8). Appellant further contends that Kennelly does not remedy this deficiency and “discloses translating text of a computer user interface by using separate language-specific files, which are stored in separate language-specific subdirectories, for each respective language translation.” (App. Br. 9, Reply Br. 2). According to Appellant, neither Flanagan nor Kennelly discloses the claimed limitation of receiving an electronic file which includes a plurality of translations/languages for at least one word/phrase.

We agree with Appellant. The Examiner, nevertheless, maintains that “Kennelly is combined with Flanagan to teach” the claimed limitation (Ans. 15). The Examiner further maintains that the drop down box 218 may present multiple available languages and if a user selects one language the management object request processor 156 locates a language.txt file in a subdirectory from language data files 220en, 220jp and 220fr (Ans. 15-16). However, we find that the Examiner’s reliance upon Kennelly to reject this express limitation of claim 6 is not well founded since the portions of Kennelly relied upon by the Examiner only discuss the process of selecting a language from the drop down menu box and obtaining a selected language page from the data files 220en, 220jp and 220fr (not from the received electronic file). We find that what the user received is an electronic file (or

page) with only one language because the displayed translated page is retrieved from one of the data files (FF1).

Thus, we find the Examiner erred in reading the receiving page/electronic file with one language (loaded from one data file 220) in Kennelly as receiving electronic file including plural languages for at least a word/phrase. Finally, from the other cited portions of Kennelly, we find no express disclosure or fair suggestion by the Examiner for the argued limitations of independent claim 6.

We next look to the teachings of Flanagan. The Examiner has merely relied upon Flanagan for the limitation concerning the partially encrypted file. The Examiner has not identified how the teachings of Flanagan remedy the above noted deficiency (Ans. 7-9). We find that Flanagan does not disclose or fairly suggest the argued limitations because the received page by the user for displaying contains only one language and is retrieved from one of the caches with pre-translated languages (FF2). We also find that the combination of Flanagan and Kennelly does not teach or fairly suggest the argued limitations because none of the cited references teaches or fairly suggests the argued limitations.

Hence, we find that the Examiner has not made a showing of obviousness as required to teach or fairly suggest the invention as recited in claim 6 by the combination of teachings of Flanagan and Kennelly. Since independent claim 1 contains the common limitations, we also find that the Examiner has not made a requisite showing of obviousness as required to

teach or fairly suggest the invention as recited in claim 1 by the combination of teachings of Flanagan and Kennelly.

Accordingly, we agree with Appellant that the Examiner failed to show that the combination of Flanagan and Kennelly teaches or fairly suggests the claimed limitation of receiving an electronic file which includes a plurality of translations/languages for at least one word/phrase. The rejection of the dependent claims 2-5 and 7-13 contains the same deficiency. Appellant, thus, has demonstrated error in the Examiner's *prima facie* case for the obviousness rejection of the subject matter of claims 1-13.

Therefore, we cannot sustain the obviousness rejection of claims 1-13 under 35 U.S.C. § 103 over the combination of Flanagan and Kennelly.

VI. CONCLUSION

We conclude that Appellant has shown the Examiner erred by failing to identify a teaching of “assigning to at least one word in the electronic file a plurality of identifiers, wherein each identifier corresponds to one of a plurality of respective translations in the electronic file for said at least one word;... receiving the electronic file...to obtain, from the respective translations in the electronic file, a translation, in the language selected by the user, for said at least one word” in the prior art, as recited in claim 6.

VII. ORDER

We reverse the obviousness rejection of claims 1-13.

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REVERSED

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